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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,376	07/24/2003	Robert S. Greeff	57226-A-RE	2506
20311 7590 04/30/2009 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
LAVINDER, JACK W				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
04/30/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/626,376

**Applicant(s)**

GREEFF, ROBERT S.

**Examiner**

Jack W. Lavinder

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

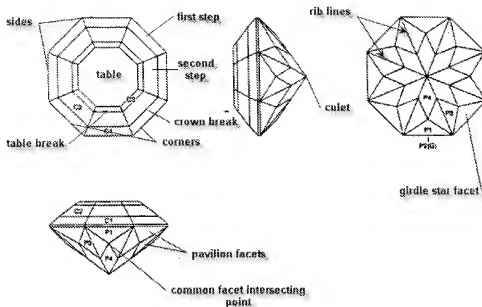
**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

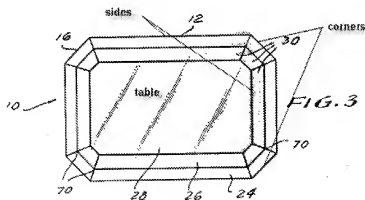
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over non-Patent literature reference, Gram Faceting Designs (GFD) in view of Grossbard, 4020649. GFD discloses a mixed cut diamond (step cut on the crown and brilliant cut on the pavilion. GFD's stone is octagonal in shape with corner crown lengths equal to corner side lengths and four table corner lengths equal to four table side lengths. The pavilion has a culet point with eight rib lines extending in a straight line from the girdle to the culet. The crown also comprises at least two steps with a flat table (see annotated figure). The number and shape of the facets on the pavilion as defined in the claims are shown in GFD.



The claims recite that the corner lengths of the crown and table are substantially less than the side lengths of the crown and table. GFD discloses the lengths to be the same.

Grossbard, 4020649, discloses a mixed-cut gemstone having corner lengths less than the side lengths of the table and crown.



The courts have noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art.

*In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). The shape of the stone is considered to be ornamental and serves no mechanical function. Therefore, it would have been an obvious design choice to make GFD's stone into the shape of Grossbard's stone in order to change the aesthetical appearance of the stone.

***Response to Arguments***

Applicant's arguments filed 10/20/2008 have been fully considered but they are not persuasive.

The declarations under 37 CFR 1.132 filed 10/20/2008 and 4/8/2009 are insufficient to overcome the rejection of claims 1-23 based upon Gram Faceting Designs in view of Grossbard, 4020649. The applicant is trying to prove that the commercial success is based on the novel cut of the gemstone. In order for the shape of a gemstone, i.e., the number, shape and orientation of the facets on the crown and pavilion and the shape of the crown and pavilion, to be considered a patentable gemstone, the applicant must submit proof that the shape, cuts and facets produce an unexpected effect in the visual appearance of the stone. The applicant must submit proof that the fire, brilliance and scintillation of the stone has been increased to an unexpected level. The only evidence submitted by applicant are the declarations alluding to commercial success.

Convincing proof that the shape of the stone produces unexpected fire, brilliance and scintillation would be scientific experiments measuring the fire, brilliance, scintillation produced by the stone as compared to what would be expected from a prior art gemstone. The declarations alluding to commercial success based on the shape and arrangement of the facets on the stone falls short of linking the success to the unexpected fire, brilliance and scintillation produced by the stone.

There are other reasons why the gemstone in the application is enjoying success that are totally

unrelated to the patentable features of the stone. The style of the stone could be the sole reason for commercial success. Jewelry fashions are constantly changing, which is similar to sunglasses fashions. The commercial success of a new sunglasses style doesn't mean that the change in shape and size of the sunglasses makes the device patentable. The same goes for gemstones, i.e., a change in the shape, number and orientation of the facets doesn't make the gemstone patentable. Therefore, more evidence of how the shape, size, orientation of the facets and the relationship between the crown and pavilion must be submitted to prove that these features provide an unexpected increase in the fire, scintillation and brilliance of the gemstone, which is leading it to having commercial success in the marketplace.

### ***Conclusion***

This is an RCE of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jack W Lavinder/  
Primary Examiner, Art Unit 3677  
4/28/2009